

## **REMARKS**

Claims 1, 2, 4, 5, and 31 – 43 were pending in the Application prior to the outstanding Office Action. In the Listing of Claims above, Applicant has amended claims 1, 4, 5, 31 – 34, 36, 37, 39, 40, 42, and 43, and has added Claims 44 – 52.

In the Office Action, the Examiner rejected claims 1, 2, 4, 5 and 31 – 38 under 35 U.S.C. §102(e), and claims 39 – 43 under 35 U.S.C. §103(a). Each of these rejections is discussed below.

### **I. RESPONSE TO REJECTIONS UNDER 35 U.S.C. §102(e)**

In the Office Action, the Examiner rejected claims 1, 2, 4, 5 and 31 – 38 as being anticipated by U.S. Patent 6,011,794 by Mordowitz et al. ("Mordowitz"). Applicant notes that Mordowitz was filed on September 9, 1996 which post-dates the Applicants date of invention. Mordowitz therefore does not constitute §102(e) prior art. Nevertheless, the present claims are clearly distinguishable over Mordowitz as explained below and the Applicant presently responds on that basis.

#### **Overview of Mordowitz**

Mordowitz discloses a system in which voice signals are transmitted between a caller and receiver in real-time in order to accomplish a live telephone call over the Internet. See for example column 2, lines 25-41, which discusses "telephone to telephone calling through the internet" and the ability to "convert analog voice originating at each telephone set to a stream of compressed digital voice suitable for transmission over the internet." See also column 3, lines 11-18, and column 4, lines 45-54. In the latter passage Mordowitz explains that "[t]he two parties 18, 22 can now freely converse (step 106) with one another over the Internet during which analog voice signals emanating from the telephones are continuously converted ..."

There is no teaching or suggestion in Mordowitz to convert a voice signal into a voice message and then to transmit the recorded voice message over the Internet. In fact, Mordowitz teaches away from such an embodiment since the motivation is based on the establishment of real-time two-way communication. The system disclosed in

Mordowitz would not be useable except in the case that a real-time connection is established directly between the caller and the recipient.

Additionally, it should be noted that the Applicant discusses real-time voice communication over the Internet, such as in Mordowitz, in the background of the current application on page 2, lines 3-12.

**Independent claims 1, 4 and 34 are patently distinguishable over Mordowitz**

In contrast to Mordowitz, independent claims 1, 4 and 34 relate to transferring completed voice messages over a network, not real-time voice signals. For example, in one embodiment, the present invention records a message from a caller into a voice message and then transmits the voice message over the Internet. This type of communication is not real-time and is unidirectional.

Independent claim 1 as amended recites, among other things, "a voice encoding device configured to ... generate a digital message," and "a transmission device configured to transmit said digital message," and recites that the transmission device "transmits said digital message through said network after said voice encoding device generates said digital message." Mordowitz does not disclose, teach or suggest any embodiment in which a voice message is generated and subsequently transmitted. Mordowitz relates only to the real-time streaming of voice signals from a caller directly to a recipient. Independent claim 1 is therefore not anticipated by nor rendered obvious in view of Mordowitz.

Similarly, independent claim 4 as amended recites, among other things, "encoding [a] voice signal into a digital message," and "transmitting said digital message over a network," and recites that the transmitting occurs "after said step of encoding." Mordowitz does not disclose, teach or suggest any embodiment in which a voice message is encoded and subsequently transmitted. Mordowitz relates only to the real-time streaming of voice signals from a caller directly to a recipient. Independent claim 4 is therefore not anticipated by nor rendered obvious in view of Mordowitz.

Independent claim 34 as amended recites, among other things, “a receiving device configured to receive a digital message” and “a voice decoding device configured to decode said digital message and generate a first voice signal,” and recites that the decoding device “generates said first voice signal after said receiving device receives said digital message.” Mordowitz does not disclose, teach or suggest any embodiment in which a voice message is received and subsequently decoded into a voice signal. Mordowitz relates only to the real-time streaming of voice signals from a caller directly to a recipient. Independent claim 34 is therefore not anticipated by nor rendered obvious in view of Mordowitz.

**Dependent claims 2, 5, 31 – 33, 35 – 38 and 44 - 51 are patently distinguishable over Mordowitz**

Dependent claims 2, 31 – 33 and 44 – 46 dependent directly or indirectly from independent claim 1. Dependent claims 5, 38 and 48 – 51 dependent directly or indirectly from independent claim 4. Dependent claims 35 – 37 and 47 depend directly or indirectly from independent claim 34. These dependent claims include all of the limitations of the independent claim from which they depend. Applicants respectfully assert that dependent claims 2, 31 – 33 and 44 – 46 are allowable for at least the reasons set forth above concerning independent claims 1, 4 and 34.

**II. RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)**

In the Office Action, the Examiner rejected claims 39 - 43 as being unpatentable over Mordowitz in view of U.S. Patent 5,155,760 by Johnson et al. (“Johnson”).

**Overview of Johnson**

Johnson discloses an improvement to traditional voice mail systems and answering machines to allow “barge in” of the outgoing message by the recipient. See for example column 2, lines 10-22. This involves a signal enhancement device and a speech detection device as described in column 2, lines 32-50. The motivation behind Johnson is to allow users listening to an outgoing message to start speaking before the outgoing message has completed.

Johnson does not relate to the transmission of voice messages over a network, but merely to traditional voice mail systems and answering machines that record voice messages. See for example column 1, lines 12-24, and column 6, lines 1-25, and lines 45-65. There is no teaching or suggestion in Johnson to transmit a recorded message. In fact, Johnson only discusses the recording of a message peripherally since the disclosure is concerned mainly with an improved method of recognizing when an outgoing message should be interrupted and a recording should be started. The traditional voice mail and answering machines disclosed in Johnson are not capable of transmitting messages; they are only capable of recording messages and playing them back.

**Independent claims 4 and 40 are distinct over Mordowitz in view of Johnson**

Independent claim 4 as amended recites, among other things, "encoding [a] voice signal into a digital message," and "transmitting said digital message over a network," and recites that the transmitting occurs "after said step of encoding." Mordowitz in view of Johnson does not disclose, teach or suggest any embodiment in which a voice message is encoded and subsequently transmitted. Mordowitz relates only to the real-time streaming of voice signals from a caller directly to a recipient and Johnson relates only to traditional voice mail systems and answering machines in which messages are recorded but never transmitted. It is impossible to combine Mordowitz with Johnson to get a system as recited in claim 4. Independent claim 4 is therefore not rendered obvious by Mordowitz in view of Johnson.

Independent claim 40 as amended recites, among other things, "receiving a digital message," and "decoding said message to generate a first voice signal," and states that the decoding step takes place "after said step of receiving." Mordowitz in view of Johnson does not disclose, teach or suggest any embodiment in which a voice message is received and subsequently decoded. Mordowitz relates only to the real-time streaming of voice signals from a caller directly to a recipient and Johnson relates only to traditional voice mail systems and answering machines in which messages are

played back but never transmitted or received. It is impossible to combine Mordowitz with Johnson to get a system as recited in claim 40. Independent claim 40 is therefore not rendered obvious by Mordowitz in view of Johnson.

**Dependent claims 39, 41 – 43 and 52 are distinct over Mordowitz in view of Johnson**

Dependent claim 39 depends directly from independent claim 4. Dependent claims 41 – 43 and 52 depend directly from independent claim 40. These dependent claims include all of the limitations of the independent claim from which they depend. Applicants respectfully assert that dependent claims 39, 41 – 43 and 52 are allowable for at least the reasons set forth above concerning independent claims 4 and 40.

**Additional Remarks**

The additional reference cited by the Examiner but not relied upon has been reviewed. This reference does not constitute §102(e) prior art based upon its filing date, and nevertheless does not anticipate nor render obvious, alone or in combination with any other known reference any existing claim. In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application are allowable, and a Notice of Allowance is requested.

Respectfully submitted,

Date: November 2, 2006

By: /Stephen Melvin/

---

Stephen W. Melvin  
Reg. No. 50,467

Stephen W. Melvin, Ph.D.  
Zytek Communications Corporation  
One Market Plaza, Spear Tower, Suite 3600  
San Francisco, California 94105  
Voice: (415) 738-8734  
Facsimile: (415) 839-7266  
Email: melvin@zytek.com